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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/920,902	08/03/2001	Amine Abina	065691-0246	9796
22428	7590	10/24/2003	EXAMINER	
FOLEY AND LARDNER SUITE 500 3000 K STREET NW WASHINGTON, DC 20007			WEHBE, ANNE MARIE SABRINA	
			ART UNIT	PAPER NUMBER
			1632	

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/920,902

Applicant(s)

ABINA, AMINE

Examiner

Anne Marie S. Wehbe

Art Unit

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 03 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____.

3. ☒ Applicant's reply has overcome the following rejection(s): see attached sheets.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached sheets.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1, 4-11, 13-16, 19, 27, 29, 30, 43-47 and 72-88.

Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

ATTACHEMENT TO ADVISORY ACTION

3. cont. Applicant's cancellation of claims 2-3, 17-18, 20-26, 28, 31-42, and 48-71 have resulted in the withdrawal of all rejections/objections over these claims. The rejection of claims 1, 4-11, 27, 29-30, and 43-47 under 35 U.S.C. 112, second paragraph, is withdrawn in view of applicant's amendments to the claims.

5. cont. Applicant's amendments and arguments do not overcome the rejection under 35 U.S.C. 112, first paragraph, of record over claims 1, 3-16, 19, 27, 29-30, 43-47, and 72-88. The applicant argues that the claims should be interpreted verbatim and that issues regarding therapeutic expression of the heterologous protein and gene therapy are not relevant to the claimed invention since the claims do not specifically recite these issues. In determining enablement under 35 U.S.C. 112, first paragraph, however, the MPEP states that during patent examination, the pending claims must be "given their broadest reasonable interpretation consistent with the specification." *In re Hyatt*, 211 F.3d 1367, 1372, 54 USPQ2d 1664, 1667 (Fed. Cir. 2000). MPEP 2111. Case law further states that "Claims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their broadest reasonable interpretation." *In re Marosi*, 710 F.2d 799 at 802, 218 USPQ 289 (Fed. Cir. 1983), (quoting *In re Okuzawa*, 537 F.2d 545, 548, 190 USPQ 464, 466 (CCPA 1976)) (emphasis in original). Furthermore, contrary to applicant's assertion that none of the claims as amended recite a method of therapy, claims 29-30 continues to recite, "A method for therapy of an mammal affected by a disease...", where the disease recited include auto-immune diseases, inflammatory diseases, cancer, viral infections, bacterial infections, parasitic infections, and fungal infections. In addition, the specification on pages 1-4 very clearly states that the instant methods are intended to provide a solution to the problem of a lack of persistent and sustained expression of transgenes in gene therapy and animal transgenesis. While applicant's amendments have narrowed the scope of the claims to wherein the "agent" is an adenovirus, the claims are still broad and the specification fails to provide an enabling disclosure for the full scope of the invention as claimed for reasons discussed in detail in previous office actions. Thus, for reasons of record, the rejection stands.

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Any inquiry concerning this communication from the examiner should be directed to Anne Marie S. Wehbé, Ph.D., whose telephone number is (703) 306-9156. The examiner can be reached Monday-Friday from 10:30-7:00. If the examiner is not available, the examiner's supervisor, Deborah Reynolds, can be reached at (703) 305-4051. General inquiries should be directed to the group receptionist whose phone number is (703) 308-0196. The technology center fax number is (703) 872-9306. Please note that Official papers can no longer be received by the examiner's direct Rightfax number.

Dr. A.M.S. Wehbé

ANNE M. WEHBE' PH.D
PRIMARY EXAMINER

A handwritten signature in black ink, appearing to read 'Anne M. Wehbé', with a stylized flourish at the end.